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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,190	07/23/2001	Jace N. Green	077056-0359	2932

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EXAMINER

OH, SIMON J

ART UNIT PAPER NUMBER

1615

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

10D

<b>Office Action Summary</b>	<b>Application No.</b> 09/911,190	<b>Applicant(s)</b> GREEN ET AL.	
	<b>Examiner</b> Simon J. Oh	<b>Art Unit</b> 1615	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-31,36,37 and 60-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-31,36,37 and 60-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-23-01</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Papers Received***

Receipt is acknowledged of the applicant's response to the election requirement, as well as a listing of the currently pending claims, both received on 04 November 2003.

### ***Claim Objections***

Claim 61 is objected to for the following informalities:

In the listing of pending claims most recently submitted by the applicant, Claim 60, from which Claim 61 depends, is marked as being cancelled. The examiner requests clarification as to whether or not Claim 60 is actually cancelled and to change the dependency of Claim 61 if necessary. In order to advance prosecution, the examiner will assume that the listing of Claim 60 as being cancelled was made in error and that it is still a pending claim.

### ***Election/Restrictions***

The election requirement of 03 October 2003 has been withdrawn.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19-31, 36, 37, and 60-96 are rejected under the judicially created doctrine of double patenting over Claims 1-27 of U. S. Patent No. 5,888,639. Although the conflicting claims are not identical, they are not patentably distinct from each other. The claims of the '639 patent are directed to an expandable and contractible cellular panel comprising tubular cells, and methods of making thereof. Although the language of the claims in the instant application are not precisely identical with the language of the claims of the '639 patent, it is clear that there is a clear and significant overlap in the scope of each respective set of claims. It would be obvious to one of ordinary skill in the art that the basic method steps of producing the cellular panel are disclosed in both the instant application and the '639 patent and that they are substantially similar to each other, including providing at least two sheets; welding or otherwise securing the longitudinal margins of the sheets together to form a web; forming a plurality of cells; and laminating or otherwise adhering the plurality of cells by joining a section of one cell to a section of a previously formed cell. The '639 patent also discloses a method for continuous production of a panel (See Claim 27).

Claims 19-31, 36, 37, and 60-96 are rejected under the judicially created doctrine of double patenting over Claims 1-17 of U. S. Patent No. 6,045,890. Although the conflicting claims are not identical, they are not patentably distinct from each other. The claims of the '890 patent are directed to an expandable and contractible cellular panel comprising tubular cells, and methods of making thereof. Although the language of the claims in the instant application are not precisely identical with the language of the claims of the '890 patent, it is clear that there is a clear and significant overlap in the scope of each respective set of claims. It would be obvious to one of ordinary skill in the art that the basic method steps of producing the cellular panel are disclosed in both the instant application and the '890 patent and that they are substantially similar to each other, including providing at least two sheets; welding or otherwise securing the longitudinal margins of the sheets together to form a web; forming a plurality of cells; and laminating or otherwise adhering the plurality of cells by joining a section of one cell to a section of a previously formed cell.

Claims 19-31, 36, 37, and 60-96 are rejected under the judicially created doctrine of double patenting over Claims 1-37 of U. S. Patent No. 6,284,347 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other. The claims of the '347 patent are directed to an expandable and contractible cellular panel comprising tubular cells. Although the claims in the instant application are drawn to methods of production and the claims of the '347 patent are drawn to product, it is clear that the claims of the '347 patent are defined in part by limitations concerning the method by which the disclosed panels are produced. Hence,

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there is a clear and significant overlap in the scope of each respective set of claims. It would be obvious to one of ordinary skill in the art that the basic method steps of producing the cellular panel are disclosed in both the instant application and the '347 patent and that they are substantially similar to each other, including providing at least two sheets; welding or otherwise securing the longitudinal margins of the sheets together; forming a plurality of cells; and laminating or otherwise adhering the plurality of cells by joining a section of one cell to a section of an adjacent cell.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Corey *et al.* patent, U.S. Patent No. 5,193,601, discloses a method and apparatus for the manufacture of a multi-cellular collapsible shade.

The Lajovic patent, U.S. Patent No. 5,409,559, discloses a method and apparatus of continuously forming a tubular body.

The Colson *et al.* patent, U.S. Patent No. 5,482,750, discloses a multiple cell honeycomb panel, capable of being expanded and contracted.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon J. Oh whose telephone number is (703) 305-3265. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

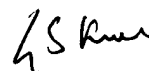
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Simon J. Oh  
Examiner  
Art Unit 1615

sj0



Gollamudi S. Kishore, PhD  
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